

REMARKS

(1) Claims 13-22 are pending in this application. Claims 13 and 15 have been amended. It is believed that these amendments are fully responsive to the Office Action dated **August 14, 2002**.

The basis of the amendments is found at page 20, lines 3-12. It is noted that the amendments in Claims 13 and 15 are intended to overcome the rejection under 35 U.S.C. 112, the first and second paragraphs, and not intended to overcome the rejection under 35U.S.C.103(a). It is apparent from the specification that the polymer containing at least one alkenyl group can't be a saturated polymer.

(2) Claim Objections

The amendments are believed to overcome the objections.

(3) Claim Rejections under 35 U.S.C.112

The amendments in Claims 13 and 15 are believed to overcome the rejections under 35 U.S.C. 112, the first and second paragraphs.

(4) Claim Rejections under 35 U.S.C. 103(a)

Claims 13-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawakubo et al. (4,788,254, hereinafter "Kawakubo") in view of Azechi et al. (5,942,583, hereinafter "Azechi").

(I) As stated by the Examiner, Kawakubo does not disclose a specific primer composition.

Azechi discloses a primer composition. However, the coating composition used in Azechi is typically any of well known silicone elastomer composition (col.19, lines 51-53). Following this disclosure, only organopolysiloxanes are exemplified. On the other hand, Kawakubo discloses a curable composition comprising a hydrocarbon polymer (col.3, line1 -col.4 line 33), which is quite different from the organopolysiloxane disclosed in Azechi in view of the element and adhesiveness. Therefore, the disclosure of Azechi teaches away from the disclosure of Kawakubo.

(II) In addition, the examiner argues that it would have been obvious to one of ordinary skill in the art at the time of the invention to have applied the primer composition as taught by Azechi as the primer in the coating process of Kawakubo, because Azechi teaches that applying a primer layer increases adhesion to a plastic substrate resulting in a higher quality product. However, one of ordinary skill would not have been motivated to apply the primer composition of Azechi to the coating process of Kawakubo.

In the first instance, there must be a basis in the art for combining the references or modifying references. The mere fact that the references can be combined or modified does not render the resultant combination obvious, unless the prior art also suggests the desirability of the combination. That the primer composition, missing element in Kawakubo, may be extracted from Azechi and combinable with Kawakubo does not suggest the desirability of the combination.

In the second instance, prima facie obviousness requires a reasonable expectation of success.

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Kawakubo does not teach any problems that a primer composition is necessary. Therefore, there is no suggestion that the primer composition of Azechi is combined with the process of Kawakubo. An obvious to try standard is not a proper basis for a rejection under 35 USC 103.

(III) Regarding Claims 16 and 17, the Examiner states that Kawakubo discloses a curing agent comprising two or more silicon-bound hydrogen atoms per molecule. However, Kawakubo does not disclose a compound containing Si-H. See formula (IV) at col.7, line30, with reference to "R" and "X" at col.3, lines 33-41.

(5) In view of the aforementioned amendments and accompanying remarks, claims, as amended, are in condition for allowance, which action, at an early date, is requested.

If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact Applicant's undersigned attorney at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

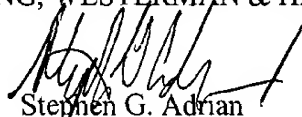
Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned "**Version with markings to show changes made.**"

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In the event that this paper is not timely filed, Applicant respectfully petitions for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully submitted,

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PATENT TRADEMARK OFFICE

Enclosures: Version with markings to show changes made

IN THE CLAIMS:

Please amend claims 13 and 15 as follows:

13. (Amended) A bonding method for bonding a cured product to a substrate which comprises coating a primer composition comprising a silane coupling agent as (B) component on a substrate, ~~and~~ applying a curable composition comprising a ~~saturated~~ hydrocarbon polymer having at least one alkenyl group per molecule onto the primed substrate, and curing the curable composition to obtain the cured product bonded to the substrate.

15. (Amended) The bonding method according to Claim 13 or 14 wherein said ~~saturated~~ hydrocarbon polymer containing at least one alkenyl group per molecule is a polyisobutylene polymer having at least one alkenyl group terminally of its backbone and /or side chain.